

## PATENT COOPERATION TREATY

PCT

## NOTIFICATION OF ELECTION

(PCT Rule 61.2)

From the INTERNATIONAL BUREAU

To:

Assistant Commissioner for Patents  
United States Patent and Trademark  
Office  
Box PCT  
Washington, D.C.20231  
ETATS-UNIS D'AMERIQUE

in its capacity as elected Office

<b>Date of mailing</b> (day/month/year) 02 May 2000 (02.05.00)	<b>Applicant's or agent's file reference</b> PF-0559 PCT
<b>International application No.</b> PCT/US99/16164	<b>Priority date</b> (day/month/year) 16 July 1998 (16.07.98)
<b>International filing date</b> (day/month/year) 16 July 1999 (16.07.99)	
<b>Applicant</b> BANDMAN, Olga et al	

1. The designated Office is hereby notified of its election made:

☒ in the demand filed with the International Preliminary Examining Authority on:

08 February 2000 (08.02.00)

☐ in a notice effecting later election filed with the International Bureau on:2. The election ☒ was☐ was not

made before the expiration of 19 months from the priority date or, where Rule 32 applies, within the time limit under Rule 32.2(b).

<b>The International Bureau of WIPO</b> 34, chemin des Colombettes 1211 Geneva 20, Switzerland	<b>Authorized officer</b>  Olivia RANAIVOJAONA
Facsimile No.: (41-22) 740.14.35	Telephone No.: (41-22) 338.83.38

## PATENT COOPERATION TREATY

## PCT

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

REC'D 03 AUG 2000

WIPO PCT

Applicant's or agent's file reference PF-0559 PCT		<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/US99/16164	International filing date (day/month/year) 16 JULY 1999 (16.07.1999)	Priority date (day/month/year) 16 JULY 1998 (16.07.1998)	
International Patent Classification (IPC) or national classification and IPC IPC(7): C07K 1/00 and US Cl.: 530/350			
Applicant INCYTE PHARMACEUTICALS INC.			
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>3</u> sheets, including this cover sheet.</p> <p>[ ] This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of <u>0</u> sheets.</p>			
<p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the report</p> <p>II <input type="checkbox"/> Priority</p> <p>III <input checked="" type="checkbox"/> Non-establishment of report with regard to novelty, inventive step and industrial applicability</p> <p>IV <input type="checkbox"/> Lack of unity of invention</p> <p>V <input type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p>VI <input type="checkbox"/> Certain documents cited</p> <p>VII <input type="checkbox"/> Certain defects in the international application</p> <p>VIII <input type="checkbox"/> Certain observations on the international application</p>			
Date of submission of the demand 08 February 2000 (08.02.2000)		Date of completion of this report	
Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703)305-3230		Authorized officer <i>Ullrich Winkler, Ph.D.</i> Telephone No. 703-308-0196	

Form PCT/IPEA/409 (cover sheet)(July 1998)

# INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US99/16164

## I. Basis of the report

### 1. With regard to the **elements** of the international application:\*

☒ the international application as originally filed.

☒ the description:

pages 1-50 \_\_\_\_\_ as originally filed

pages NONE \_\_\_\_\_, filed with the demand

pages NONE \_\_\_\_\_, filed with the letter of \_\_\_\_\_.

☒ the claims:

pages 51 and 52 \_\_\_\_\_, as originally filed

pages NONE \_\_\_\_\_, as amended (together with any statement) under Article 19

pages NONE \_\_\_\_\_, filed with the demand

pages NONE \_\_\_\_\_, filed with the letter of \_\_\_\_\_.

☒ the drawings:

pages 1-17 \_\_\_\_\_, as originally filed

pages NONE \_\_\_\_\_, filed with the demand

pages NONE \_\_\_\_\_, filed with the letter of \_\_\_\_\_.

☒ the sequence listing part of the description:

pages 1-7 \_\_\_\_\_, as originally filed

pages NONE \_\_\_\_\_, filed with the demand

pages NONE \_\_\_\_\_, filed with the letter of \_\_\_\_\_.

### 2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).

☐ the language of publication of the international application (under Rule 48.3(b)).

☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

### 3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

☒ contained in the international application in printed form.

☒ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority in written form.

☐ furnished subsequently to this Authority in computer readable form.

☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

### 4. ☐ The amendments have resulted in the cancellation of:

☐ the description, pages NONE

☐ the claims, Nos. NONE

☐ the drawings, sheets/fig NONE

### 5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).\*\*

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

\*\* Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US99/16164

**III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

1. The question whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been and will not be examined in respect of:

☐ the entire international application,

☒ claims Nos. 15-18

because:

☐ the said international application, or the said claim Nos. \_\_\_\_\_ relate to the following subject matter which does not require international preliminary examination (*specify*):

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. \_\_\_\_\_ are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. \_\_\_\_\_ are so inadequately supported by the description that no meaningful opinion could be formed.

☒ no international search report has been established for said claims Nos. 15-18

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

☐ the written form has not been furnished or does not comply with the standard.

☐ the computer readable form has not been furnished or does not comply with the standard.

# INTERNATIONAL SEARCH REPORT

International Application No  
PCT/US 99/16164

## A. CLASSIFICATION OF SUBJECT MATTER

IPC 7 C12N15/53 C12N9/02 C12N5/10 A61K48/00 C12Q1/68  
C07K16/28

According to International Patent Classification (IPC) or to both national classification and IPC

## B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

IPC 7 C12N A61K C07K C12Q

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

## C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	GABRIELLI, F. ET AL.: " A nuclear protein, synthesized in growth-arrested human hepatoblastoma cells, is a novel member of the short-chain alcohol dehydrogenase family." EUR. J. BIOCHEM., vol. 232, no. 2, 1 September 1995 (1995-09-01), pages 473-477, XP000862845 cited in the application the whole document --- -/-	1

☒ Further documents are listed in the continuation of box C.

☐ Patent family members are listed in annex.

### \* Special categories of cited documents :

- "A" document defining the general state of the art which is not considered to be of particular relevance
- "E" earlier document but published on or after the international filing date
- "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- "O" document referring to an oral disclosure, use, exhibition or other means
- "P" document published prior to the international filing date but later than the priority date claimed

- "T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
- "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
- "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.
- "&" document member of the same patent family

Date of the actual completion of the international search

5 January 2000

Date of mailing of the international search report

31.03.00

Name and mailing address of the ISA

European Patent Office, P.B. 5818 Patentlaan 2  
NL - 2280 HV Rijswijk  
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,  
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Authorized officer

CHAM BONNET, F

# INTERNATIONAL SEARCH REPORT

International Application No

PL 1/US 99/16164

## C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	DONADEL, G. ET AL.: "Identification of a novel nuclear protein synthesized in growth-arrested human hepatoblastoma HepG2 cells." EUR. J. BIOCHEM. 195, 723-729, 1991, XP000863211 the whole document	1
P,X	FRANSEN M, VAN VELDHOVEN PP, SUBRAMANI S: " Identification of peroxisomal proteins by using M13 phage protein VI phage display: molecular evidence that mammalian peroxisomes contain a 2,4-dienoyl-CoA reductase." BIOCHEM JOURNAL, vol. 340, no. PT 2, 1 June 1999 (1999-06-01), pages 561-568, XP000862955 the whole document	1,2

# INTERNATIONAL SEARCH REPORT

International application No.

PCT/US 99/ 16164

## Box I Observations where certain claims were found unsearchable (Continuation of item 1 of first sheet)

This International Search Report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. ☒ Claims Nos.:  
because they relate to subject matter not required to be searched by this Authority, namely:  
Remark: Although claims 17 and 18  
are directed to a method of treatment of the human/animal  
body, the search has been carried out and based on the alleged  
effects of the compound/composition.
2. ☒ Claims Nos.: 15-16  
because they relate to parts of the International Application that do not comply with the prescribed requirements to such  
an extent that no meaningful International Search can be carried out, specifically:  
see FURTHER INFORMATION sheet PCT/ISA/210
3. ☐ Claims Nos.:  
because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

## Box II Observations where unity of invention is lacking (Continuation of item 2 of first sheet)

This International Searching Authority found multiple inventions in this international application, as follows:

see additional sheet

1. ☐ As all required additional search fees were timely paid by the applicant, this International Search Report covers all  
searchable claims.
2. ☐ As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment  
of any additional fee.
3. ☐ As only some of the required additional search fees were timely paid by the applicant, this International Search Report  
covers only those claims for which fees were paid, specifically claims Nos.:
4. ☒ No required additional search fees were timely paid by the applicant. Consequently, this International Search Report is  
restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

1 to 20 partially

Remark on Protest

- ☐ The additional search fees were accompanied by the applicant's protest.
- ☐ No protest accompanied the payment of additional search fees.

# INTERNATIONAL SEARCH REPORT

International Application No. PCT/US 99/16164

FURTHER INFORMATION CONTINUED FROM PCT/ISA/ 210

Continuation of Box I.2

Claims Nos.: 15 16

Present claims 15 and 16 relate to respectively an agonist and an antagonist of the polypeptide of claim 1 without giving true technical characterization. In consequence, the scope of said claims is ambiguous and vague, and their subject matter is not sufficiently disclosed and supported (Articles 5 and 6 PCT). No search can be carried out for such purely speculative claims whose wording is, in fact a mere recitation of the results to be achieved.

The applicant's attention is drawn to the fact that claims, or parts of claims, relating to inventions in respect of which no international search report has been established need not be the subject of an international preliminary examination (Rule 66.1(e) PCT). The applicant is advised that the EPO policy when acting as an International Preliminary Examining Authority is normally not to carry out a preliminary examination on matter which has not been searched. This is the case irrespective of whether or not the claims are amended following receipt of the search report or during any Chapter II procedure.

## INTERNATIONAL SEARCH REPORT

International Application No. PCT/US 99/16164

FURTHER INFORMATION CONTINUED FROM PCT/ISA/ 210

1. Claim : partially 1 to 20

A substantially purified polypeptide comprising an amino-acid sequence consisting of SEQ ID NO:1 ,a variant having at least 90% amino acid identity or fragment thereof ; an isolated and purified polynucleotide encoding said polypeptide, or comprising a sequence selected from the group consisting of SEQ ID NO:3, a fragment, a variant or a complementary polynucleotide thereof; an expression vector comprising said polynucleotide, a host cell comprising said vector and method of production using it; a pharmaceutical composition comprising said polypeptide and uses thereof, a purified antibody which specifically binds to said polypeptide, a purified agonist or antagonist of said polypeptide; methods for detecting such a polynucleotide.

2. Claim : partially 1 to 20

A substantially purified polypeptide comprising an amino-acid sequence consisting of SEQ ID NO:2 ,a variant having at least 90% amino acid identity or fragment thereof ; an isolated and purified polynucleotide encoding said polypeptide, or comprising a sequence selected from the group consisting of SEQ ID NO:4, a fragment, a variant or a complementary polynucleotide thereof; an expression vector comprising said polynucleotide, a host cell comprising said vector and method of production using it; a pharmaceutical composition comprising said polypeptide and uses thereof, a purified antibody which specifically binds to said polypeptide, a purified agonist or antagonist of said polypeptide; methods for detecting such a polynucleotide.